

REMARKS

In Section 1 of the Non-Final Office Action of August 23, 2005 claims 25, 28, 31 and 34 were rejected under 35 U.S.C. 102(e) as being anticipated by Kohli et al. U.S. Patent 6,393,046. The Applicant believes that the Examiner's statements are not accurate and need further clarification. The Examiner's arguments are analyzed based on MPEP guidelines which are stated in the MPEP Paragraph 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. .... "The identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. ...

Regarding independent claim 1, contrary to the Examiner's statement that all elements and claim limitations are disclosed by Kohli et al., it is evident to the Applicant that Kohli et al. do not disclose "a first delay time, where the first delay time is set outside of the assumed correlation function area", recited in claim 1 of the present invention (e.g., see point E1 in figures 3 and 4 of the present invention). All delay times taught by Kohli et al. are inside of the assumed correlation function area as can be seen in

Figure 17 and in the text of Kohli et al.'s patent (e.g., see col. 38, line 65 through col. 42, line 18) contrary to what is taught in claim 1 of the present invention.

Moreover, Kohli et al. do not disclose the following step of claim 1: generating a replica code corresponding to the pseudo-random noise (PRN) code of the received signal;". Kohli et al. mentions a synthesized replica of the signal in col. 7, lines 35-36. The applicant believes that this synthesized replica of Kohli et al. is different from the replica code recited in claim 1 of the present invention. The synthesized replica of Kohli et al., referred to by the Examiner, is generated by "processing the composite of direct and multipath signals as received" and "which can be subtracted from the signals as received to cancel or eliminate the effects of the non-direct path, unwanted multipath signals" (see col. 7, lines 33-38 of Kohli et al.). In contrast, the replica code of claim 1 of the present invention is generated by a replica code generator **22**, as shown in Figure 1, and corresponds to the pseudo-random noise (PRN) code of the received signal and not subtracted from the signals as received, contrary to what is taught by Kohli et al.

Finally, Kohli et al. do not disclose the last step of claim 1: "determining if the correlation results of the first and second delay times are substantially equal to each other and, if the first and second correlation results are not substantially equal to each other, adjusting the correlation timing so as to cause the first and second correlation results to be substantially equal to each other." Indeed, Kohli et al. do not even describe

the correlation results of the first and second delay times with the first delay time being outside the assumed correlation function area. But even for the correlation results described by Kohli et al., a different criterion for adjusting the correlation timing is used: "If Code Phase Error System **250** determines that the amplitude of the prompt correlation performed midway between the early and late correlations is less than twice the amplitude of the equal early and late correlations, then multipath reinforcement interference lag error 264 exists." (e.g., see amplitudes 270 and 272, 274 and 276 in Figure 17, col. 41, lines 53-57 and col. 9, lines 17-27 of Kohli et al.). In other words, Kohli et al.'s criterion for defining an error requiring subsequent adjustment is "less than twice" and not "substantially equal" as recited in claim 1 of the present invention.

Therefore, in light of the above, the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Kohli et al., is unsupported by the art and should be withdrawn per MPEP Paragraph 2131 quoted above.

Independent claims 28 and 31 of the present invention are of the same scope as claim 1. Therefore, the arguments regarding claim 1 presented above are applied to claims 28 and 31 as well and the rejection of claims 28 and 31 under 35 U.S.C. 102(e), as being anticipated by Kohli et al., is unsupported by the art and should also be withdrawn per MPEP Paragraph 2131 quoted above.

Claim 34 is dependent claim of independent claim 31. Since independent claim 31 is not anticipated by Kohli et al., dependent claim 34 is further distinguished over

Kohli, et al. Therefore the rejection of claim 34 under 35 U.S.C. 102(e) should be withdrawn per MPEP Paragraph 2131 quoted above.

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In Section 2, the Examiner rejected claims 26-27, 29-30 and 32-33 under 35 U.S. 103(a) as being unpatentable over Kohli et al.

The applicant believes that the Examiner's statements are not accurate and need further clarification.

First, regarding claims 26-27, 29-30 and 32-33, these are dependent claims (directly or indirectly) of independent claims 25, 28 and 31. Independent claims 25, 28 and 31 are not unpatentable over Kohli et al., as stated above. Since each of the dependent claims 26-27, 29-30 and 32-33 narrows the scope of the novel and non-obvious independent claims 25, 28 or 31, non-obviousness of claims 25, 28 and 31 will compel non-obviousness of claims 26-27, 29-30 and 32-33.

Furthermore, the 35 U.S.C.103(a) rejection of claims 26-27, 29-30 and 32-33 is analyzed using MPEP guidelines which are stated in the MPEP Paragraph 2143 as follows: "To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. ***In re Vaeck***, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

**First**, the Examiner does not show that Kohli et al. teach or suggest all the limitations of claims 26-27, 29-30 and 32-33 as required by the MPEP Paragraph 2143 to establish a *prima facie* case of obviousness as stated above.

**Second**, even if only for the sake of argument we assume that Kohli et al. teach or suggest all the limitations of claims 26-27, 29-30 and 32-33, the Examiner does not show that there is suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by Kohli et al. or generally available to one of ordinary skill in the art to modify the reference of Kohli et al. to arrive at the subject matter of claims 26-27, 29-30 and 32-33 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law) at the time of the invention. The Examiner's reference to "improving accuracy of estimating the prompt correlation" as being a motivation for modifying Kohli et al. to arrive at the subject matter of claim 26 describes a generic goal underlying the present invention but not specific at all for explaining why a person skilled in the art at the time of invention would choose a delay of -0.5 chip (and not something else) between the first and second delays recited in claims 25 and 26, whereas the first delay, laying outside of the correlation function area

which, is not taught by Kohli et al. at all, as explained above.

The Federal Circuit Court has several times expressly addressed the issue.

For example, in *In re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

In other words, the Examiner failed to show a *prima facie* case of obviousness because he does not show any basis present in the art at the time of the invention for modifying reference Falcon et al. (see MPEP paragraphs 2142, 2143 quoted above, and the case law) to arrive at the subject matter of claims 26-27, 29-30 and 32-33.

**Third**, the Examiner does not show that Falcon et al. provide teaching or suggestion for **the reasonable**

expectation of success by modifying teaching of Kohli et al. to arrive at the subject matter of claims 26-27, 29-30 and 32-33, as required by the MPEP paragraph 2143, quoted above to establish a *prima facie* case of obviousness.

In light of the above considerations, the Examiner does not present arguments regarding rejection of dependent claims 26-27, 29-30 and 32-33 under 35 U.S.C. 103(a) as being obvious over Kohli et al. In other words, the Examiner failed to show a *prima facie* case of obviousness, therefore rejection of claims 26-27, 29-30 and 32-33, under 35 U.S.C. 103(a) should be withdrawn per MPEP Paragraph 2143, 2142 and the case law quoted above.

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The objections and rejections of the Office Action of August 23, 2005, having been obviated or shown to be inapplicable, withdrawal thereof is requested and passage of claims 25-34 to issue is solicited.

Respectfully submitted,



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